

## REMARKS

### I. Summary of Office Action

Claims 1-5, 7-16, 18-27, and 29-33 were pending.

Claims 1, 2, 12, 13, 23, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schein et al., U.S. Patent No. 6,388,714 ("Schein") in view of Gerace, U.S. Patent No. 5,848,396 ("Gerace"), "the Schein-Gerace Combination."

Claims 3-5, 8-11, 14-16, 19-22, 25-27, and 30-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Schein-Gerace Combination in further view of Bisdikian et al., U.S. Patent No. 5,974,406 ("Bisdikian"), "the Schein-Gerace-Bisdikian Combination."

Claims 7, 18, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Schein-Gerace-Bisdikian Combination in further view of Buhrmann et al., U.S. Patent No. 5,933,778 ("Buhrmann"), "the Schein-Gerace-Bisdikian-Buhrmann Combination."

The rejections are respectfully traversed.

### II. Summary of Examiner Interview

Applicants wish to thank the Examiner for the courtesies extended during the telephonic interview on December 2, 2003. During the interview, the portions of Gerace cited by the Examiner in the October 30, 2003 Office Action were discussed (e.g., column 10, lines 9-22 and column 26, lines 40-63 of Gerace). Applicants submitted that these portions of Gerace fail to show or suggest allowing users to "**select** at least one non-television-related information source" as set forth in applicants' claims 1, 12, and 23. The Examiner agreed

with applicants and stated that he would withdraw the October 30, 2003 Action.

### III. Summary of Applicants' Reply to Office Action

Applicants file herewith a Supplemental Information Disclosure Statement for the Examiner's consideration.

Applicants have cancelled claims 3, 5, 7-11, 14, 16, 18-22, 25, 27, and 29-33 without prejudice.

Applicants have added claims 34-42 and amended claims 1, 4, 12, 15, 23, and 26 to more particularly define the invention. No new matter is being added and the new and amended claims are fully supported and justified by the originally filed specification.

The rejections are respectfully traversed as applied to applicants' new and amended claims.

### IV. Applicants' Reply to the Rejections Under 35 U.S.C. § 103(a)

For the reasons set forth in detail below, applicants respectfully request that the rejections under 35 U.S.C. § 103(a) be withdrawn.

#### A. Claims 1, 12, and 23

Independent claims 1, 12, and 23, as amended, generally relate to systems and methods for providing personalized schedule information for both television-related and non-television-related information sources using an on-line scheduling application. As set forth in applicants' amended claims 1, 12, and 23, a user "select[s] at least one television-related information source" and "at least one non-television-related information source" for providing personalized schedule information. The user also specifies "criteria for delivering information from the at least one selected

television-related information source" and "criteria for delivering information from the at least one selected non-television-related information source." The user also "select[s] a delivery scheme from a plurality of delivery schemes for delivering personalized schedule information."

Personalized schedule information is generated in response to the user-specified information. The personalized schedule information includes "television program listings" retrieved from the selected at least one television-related information source "based on the specified criteria for delivering information from the at least one selected television-related information source." The personalized schedule information also includes "schedule information for non-televised events" retrieved from the selected at least one non-television-related information source "based on the specified criteria for delivering information from the at least one selected television-related information source." The personalized schedule information is delivered "to the user based on the delivery scheme selected by the user."

Applicants respectfully submit that amended claims 1, 12, and 23 are allowable for at least the following independent reasons.

1. The Office Action Fails to Provide a Proper Motivation for Combining the References

Applicants have previously argued that no adequate reason or motivation exists to combine Schein, Gerace, and Bisdikian. See, for example, pages 20-21 of applicants' Reply to Office Action filed September 26, 2003. The Office Action contends, however, that:

it would have been obvious . . . to modify and combine the teachings of Schein-Gerace and Bisdikian to deliver the schedule information using at least one delivery scheme . . . because it would allow the system to deliver/transmit the [personalized schedule information] by various communication means at convenient times . . . according to the user preference/profile.

See page 9 of the action (citing column 2, lines 19-52 of Bisdikian).

However, Bisdikian has nothing at all to do with the configuration and delivery of user-specified schedule information for televised and non-televised events. Instead, Bisdikian merely describes a system that allows users to rank options for how they will receive notifications of product matches in an electronic commerce environment (see, for example, column 2, lines 19-52 and column 4, lines 15-30 of Bisdikian). Moreover, Schein and Gerace already provide sufficient mechanisms for delivering schedule information (e.g., via the World Wide Web), and the Examiner has failed to provide any objective reason as to *why* one skilled in the art would have been motivated to modify the approach already set forth in Schein and Gerace to achieve the benefit of applicants' claimed approach.

Applicants therefore respectfully submit that the Examiner's statement of motivation may not be used to combine the references because it merely relies on applicants' claimed technique "as a blueprint for piecing together the prior art to defeat patentability" - a practice that is insufficient as a matter of law. In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999). Indeed, there is no clear reason (as stated by the Office Action

or otherwise) why one skilled in the art would have decided to apply Bisdikian's notification ranking technique to the combined teachings of Schein and Gerace to achieve the benefit of applicants' novel approach.

Applicants respectfully submit, therefore, that the § 103 rejections should be withdrawn. See In re Rouffet, 149 F.3d 1350, 1355 ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"); see also MPEP §§ 2142 and 2143.01.

2. The Combination of References Fails to Show or Suggest Each Element Of Applicants' Claims

Even if there were an objective motivation to combine the references, the Schein-Gerace-Bisdikian Combination still fails to show or suggest each element of applicants' claims.

The Office Action concedes that applicants' feature of "providing the user with an opportunity to select at least one non-television-related information source from a plurality of non-television-related information sources" in claims 1, 12 and 23 is patentable over Schein. See page 3 of the Action. The Office Action contends, however, that this feature of applicants' claims is shown at column 10, lines 9-22 and column 26, lines 40-63 of Gerace. See *id.*

These sections of Gerace, however, merely describe that users of a Media Schedule Page may enter a zip code to receive a table of non-television-related schedule information. According to Gerace, the Media Schedule Page is hard-coded to include three tables of information from **pre-defined** information sources (e.g., initial agate information - see, for example, column 5, lines 3-7 and column 2, line 61 - column 3, line 3). These tables, which may include television program

listings, film listings, and live performance listings, and the source of their associated information, are programmed into the code of the Media Schedule Page. See the Media Schedule Page code at column 26, lines 40-63 of Gerace.

Indeed, Gerace simply allows users to filter agate information from predetermined sources using a zip code and says nothing about allowing a user to "**select** at least one non-television-related information **source from a plurality of non-television-related information sources**" as specified by applicants' independent claims 1, 12, and 23.\* Accordingly, applicants' claims 1, 12, and 23, as amended, are patentable over the Schein-Gerace Combination.

For at least the foregoing reasons, applicants respectfully submit that independent claims 1, 12, and 23 are patentable. See In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ("To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art"); see also MPEP § 2143.03. Dependent claims 2, 4, 13, 15, 24, and 26 are therefore also patentable over the Schein-Gerace Combination.\*\* See In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988) ("Dependent claims are non-obvious under 35 U.S.C. § 103 if the independent claims from which they depend are non-obvious"). The § 103 rejections should therefore be withdrawn.

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\* At most, Gerace's zip code feature may simply implicate applicants' feature of allowing users to "specify criteria for delivering information from the at least one selected television-related information source."

\*\* Applicants reserve the right to demonstrate the patentability of claims 2, 4, 13, 15, 24, and 26 based on the claimed features should prosecution of this case continue.

V. New Claims 34-42

Applicants' dependent claims 34-42 depend from independent claims 1, 12, and 23. Applicants have demonstrated that independent claims 1, 12, and 23 are patentable. Moreover, applicants respectfully submit that dependent claims 34-42 include features that are not shown or suggested by the prior art of record. Dependent claims 34-42 are therefore also patentable.\*\*\*

VI. Conclusion

The foregoing demonstrates that claims 1, 2, 4, 12, 13, 15, 23, 24, 26, and 34-42 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,



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\*\*\* Applicants reserve the right to demonstrate the patentability of claims 34-42 based on the claimed features should prosecution of this case continue.